

**REMARKS**

The indication of allowable subject matter with respect to claims 2 and 3 is appreciated.

Claim 1 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Warsta et al. (US 5,896,369) in view of Lee (US 5,973,640). The Applicant respectfully traverses this rejection for the following reason(s).

Warsta describes using a special interconnecting computer in conjunction with a mobile exchange to allow a remote workstation to be connected over a radio path for extending the connection to a designation data network; and Lee describes the utilization of a High Capacity IPC Node Board Assembly (HINA).

In Warsta, a MSC (10) is connected to the IP network (22) through an IWF (Inter Working Function). The present invention solves a problem that the Applicant finds with such a system as Warsta's.

The Examiner errs in his understanding of Warsta. For example, claim 1 calls for *private IP exchange for performing switching between mobile terminals*. Here the Examiner refers us to Warsta's mobile switching center 10. Warsta provides no teaching to indicate that mobile switching center 10 performs switching between mobile terminals.

Additionally, claim 1 calls for *a call manager for managing a call*. Here the Examiner indicates that Warsta teaches such a call manager as being "within the BSC in the BSS as in figure 1 and respective portions of the specification."

It appears, although rather unclear, that the Examiner is suggesting that Warsta has an inherent call manager.

Inherency can not be used as a basis for determining obviousness as set forth by *In Re Oelrich*, 666 f.2d 578# 581-82, 212 USPQ 323,326 (CCPA 1981) "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.];" and *In re Rijckaert*, 28 USPQ 1953, 1957 (CAFC 1993) "a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection", citing *In re Newell*, 891 F.2d 899,901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Claim 1 also calls for *a private base station controller for providing a mobile subscriber with a complete path and assigning a vocoder in response to a request for an incoming or outgoing call to process the incoming or outgoing call*. Here, the Examiner refers to the base station controller described in col. 3, line 60 as not being shown in the figures of Warsta. However, there is no teaching in Warsta that such a base station controller has the function of *providing a mobile subscriber with a complete path*, and there is no teaching in Warsta that such a base station controller has the function of *assigning a vocoder* in response to a request for an incoming or outgoing call to process the incoming or outgoing call as required by claim 1.

That is a lot to assume from the mere mention of a base station controller in col. 3, line 60.

Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

The Examiner correctly notes that Warsta's base station controller does not comprise *a high capacity IPC (Inter-Processor Communication) node board assembly; and an Internet interface connected between the high capacity IPC node board assembly and a LAN cable, wherein the Internet interface communicates with the private base station transceiver subsystem under the control of the call manager, transmits packet data received from the mobile terminal to the IP network, monitors installation or uninstallation and functional errors of the private IP exchange, and transmits monitoring results to a wire system manager in the call manager through an Ethernet port.*

Here, the Examiner applies Lee by providing an erroneous basis of obviousness, wherein the Examiner states "it would have been obvious to one of ordinary skill in the art to modify the teachings of Warsta to include the teachings of broadcasting the system time to BTS 10 through the high capacity IPC Node board via CCP belonging to the BSC as taught by Lee **in order to easily manage the status and alarm of the GSPR without using the TFCA boards**, thus decreasing the hardware complexity by controlling data service in a BSC."

The statement of obviousness by the Examiner is erroneous based on several reasons, one of which is Warsta does not teach utilizing a global positioning system receiver (GSPR), therefore there is no teaching of a **need** to easily manage the status and alarm of the GSPR. Another is that Warsta does not teach using a TFCA board, and thus there is no *prima facie* showing that hardware complexity would be decreased.

Accordingly, without a *prima facie* showing that one of ordinary skill in the art would have sought to improve Warsta by removing some unseen TFCA board, and then to manage the status and

alarm of a non-existent GSPR, without using a TFCA board, then claim 1 is not obvious, the rejection is deemed to be in error and the rejection should be withdrawn.

New claims 4-8 depend from claims 1-3 and as such are deemed to be allowable for the same reasons as indicated for claims 1-3.

The examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



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